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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,557	06/29/2001	Andrew V. Anderson	42390.P9765X	6490

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
SEVENTH FLOOR  
LOS ANGELES, CA 90025-1030

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/895,557

Applicant(s)

ANDERSON ET AL.

Examiner

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/21/05 has been entered.
2. Claims 1-33 and 36-39 are pending for examination. Newly rejection are as stated below.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See; 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-33 and 36-39 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 and 26-38 of co-pending Application No. 10/039,960. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instance claims merely adding threshold for determining importance of the event, without specifying how the threshold is derived, such limitation on reading event subject comparison.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1, 3-6, 8-11, 13-16, 18-25, 27-29, 31-33, 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (US.2003/0046421) and Avitan (US. 2003/00178546).

7. Regarding claims 1, 3, 6, 11, 13, 16, 21-25, 27-29 and 31-32, Horvitz discloses a method, a computer readable medium comprising instruction and a digital assistant, e.g., computing device ("system", hereinafter), comprising, steps, means and executable instructions for: receiving information of an event, (Fig. 1, Fig. 27); determining the level of importance of the event relative to a first person (§ 9, 11, 14-15, 65); and if the event has level of importance greater than a first threshold, and a level of importance that is below a second predetermined threshold, then taking action without contact any person (the system employed threshold level for determining appropriate actions to be taken, e.g., such as sending notification without contact

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any one when threshold level is greater than 85 and less than maximum or send notification without contact any person when threshold level equal or higher than 95 and equal or below maximum, Fig. 23-26; ¶ 17, 74-75, 83 and 105).

Horvitz does not explicitly disclose its' system includes a feature of taking an action including at least one of providing payment to an e-commerce provider, making a telephone call on behalf of the first person, rescheduling a flight and altering reservations in response to the event without contacting any person.

However, in the same field of endeavor, Avitan a wireless mobile computing telephone dialer, e.g., a digital assistant, for dialing telephone number without contacting any one (Avitan, abstract; 104 - Fig. 1; 200-Fig. 2; ¶ 4-5, 8-9, 28-33), i.e., *taking an action including at least one of providing payment to an e-commerce provider, making a telephone call on behalf of the first person*, rescheduling a flight and altering reservations in response to the event without contacting any person.

Thus, it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to expand Horvitz's application with a digital assistant's automatically dialing, without intervention from any user as suggested in Avitan, in order to enhance user convenience, reducing time consuming and error prone to manual activity (Avitan, paragraphs 8-9).

8. Regarding claims 4, 5, 14 and 15, Horvitz-Avitan discloses, user's activity includes locate user whereabouts (Horvitz, Fig. 34; ¶ 2262-2264).

9. Regarding claims 8-9, 18-19 and 33, Horvitz-Avitan discloses the invention substantially, as described in claims 1, 11 and 21, but it is silent on determining importance level includes

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consideration whether an earlier attempt was made to contact a person or rule permit action to be taken. However, such limitation is a variation of factors, which could be easily specify within scope of Horvitz teaching to perform a desirable task without modifying conceptual design.

Thus, specifying detail factors as claimed, would have been obvious to one of ordinary skilled in the art at the time of the invention was made that was a matter of implementation choice, which an artisan could have used the system as taught by Horvitz-Avitan to do so.

10. Regarding claims 10 and 20, Horvitz-Avitan discloses, referring to information exceptions to those rules (user-profile allow user to exclude message to be delivered, Horvitz, Fig. 14-16).

11. Regarding claims 36 and 38, Horvitz-Avitan discloses, using threshold to determine importance level of an event, based on the outcome, decides whether to take further action such as forward message, notifying a person as discussed above. Hence, determining whether opportunity exists for taking action is inherent feature.

12. As to claims 2, 12, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz-Avitan, as applied to claim1 and Horvitz et al (US.2003/0046421), in view of what was well known in the art.

13. Regarding claims 2 and 12, Horvitz-Avitan discloses the invention substantially, as described in claims 1 and 11, but fails to include the teaching of determining importance level by comparing subject of message with a list of subject. Official Notice is taken that level of determining level of importance by comparing subject with a list of subject of interest was well known and widely utilized in messaging communication art, e.g., e-mail filtering or messages

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subscribing system, in which allows its subscribers to specify the subject of interest in their profile for future comparison.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made that to modify level of importance determination by including well known technique in the art to expand the utility of the system.

14. Regarding claims 37 and 39, Horvitz-Avitan discloses the invention substantially, as claimed, as described in claims 21 and 27, including substantially as described in their base claims including, inherently teaches ceasing to take action, since the action taking is dictated by level of threshold. Horvitz does not explicitly disclose the system include logging inaction event. Official notice is taken that logging information were notorious at the time of the invention was made. Thus, to include a well known event logging for record action taken event would have been obvious to one of ordinary skilled in the art, because such inclusion would simplify system's activity analysis.

15. Claims 7, 17, 26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al and Avitan, as applied to claims 1, 11,21 and 27, above and further in view of Fisher et al (US. 5,835,896).

16. Regarding claims 7, 17, 26 and 30, Horvitz-Avitan discloses the invention substantially, as described, in paragraph 7 above, including, referring to information concerning the user's preferences to determine if the first person would prefer that action be taken on behalf of the first person to respond to the event without contact any person (§ 10, 70 and 79).

Despite the fact that Horvitz is silent on a feature of determining a price limitation for any action to be taken.

However, price limitation determination concept is not new, it has been utilized in convention proxy auctioning, in which a proxy bidder, e.g., computer software, is capable of determining price limitation and taking action without contact any person, i.e., bidding, increasing price, as long as price limitation is below or equal to a predetermined threshold. For instance, in the same field of endeavor, Fisher discloses an inventive concept as such (Abstract; Col. 1, line 56 - Col. 2, line 67; Col. 12, line 63 - Col. 13, line 25).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to expand a capability of assigning action taking task without contacting any person to taking action requiring payment, such as automatically bidder as suggested in Fisher, in order to enhance ability of a person who located remotely from e-commerce or auction site to progressively interacting with e-commerce or auction process without having to stay in front of computer or auction terminal, but still maintaining a capability of interacting or auctioning, which would tremendously convenient for the bidder or the first person.

17. Applicant's arguments with respect to claims 1-33 and 36-39 have been considered but are moot in view of the new ground(s) of rejection. In the remark applicant's argument with respect to the added language, has readily been addressed in paragraph 7, above.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (571) 272-3913. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj  
06/20/05